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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,471	07/20/2001	Jeffrey K. Wilkins	WIL-102	1749

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LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
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EXAMINER

BORISOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,471

Applicant(s)

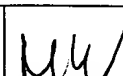
WILKINS ET AL.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, 18-29 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1, 29 and 31; the phrase "*determining local content grouping near each title extracted*" is confusing. The phrase may be understood either as combining different forms of the same terms, or collecting different type of information associated with an identified term.

Claims 2-15 and 19-28 are rejected as being dependent on claim 1.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 and 18-28 are rejected under 35 U.S.C. 101 because the claimed method for *compiling identity and contact information* does not recite a limitation in the technological arts. The independently claimed steps of: *searching the Internet to identify and obtain files containing senior management information including title, names and contact information; parsing said files to extract said title information; determining a local content grouping near each title extracted; identifying and extracting a name associated with said title from said grouping; evaluating past tense relationship of said name and title; and discarding or selecting said name and title based on said evaluating step*, are abstract ideas which can be performed mentally without interaction of a physical structure. The method step of: "*searching the Internet to identify and obtain files*" may

be understood as merely browsing the Internet, and "*parsing*", "*determining*", "*identifying*", "*evaluating*" and "*discarding*" steps may be understood as mentally analyzing the Web content, without using a computer. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (*Bd. Pat. App. & Inter.* 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-10, 13-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. (US 6,338,067) in view of Wical (US 6,061,675).

Baker et al. (hereinafter Baker) teaches a method and system for searching a structured database containing information (*files*) related to various entities, comprising:

As per claims 1, 29 and 31, searching said database over the Internet to identify and obtain information related to a company management record, management title record, management background, contact names, including addresses, telephone and fax numbers, web site and email addresses (Fig. 2; C. 3, L. 25-28; C. 6, Table II; C. 7, L. 25-41). Various types of information are relationally linked across the Internet, and accessible to a user over the net by querying key terms (individual data items) (C. 2, L. 3-16).

However, Baker does not specifically teach that said querying key terms includes parsing technique; evaluating a past tense relationship of the extracted title and name records; and selecting said records based on said evaluating step.

Wical teaches a method and system for classifying terminology utilizing a structured database, wherein a parsing technique is employed to determine a verb tense, wherein said verb is selected based on said determination (C. 78, L. 14-15; C. 52, L. 11-19, C. 70, L. 19-22).

It would have been obvious to one having ordinary skill in the art to modify Baker to include parsing the quires for key terms, and evaluating a past tense relationship of the extracted information, as disclosed in Wical, because it would enhance the capability of the system by allowing to tailor a search strategy to specific needs of the user, thereby increase the market value of the system.

As per claims 5-10, obtaining said information over the Internet obviously indicates accessing websites (Baker; C. 3, L. 25-26). Information as to “corporate”, “magazine”, “newspaper”, “press release”, “professional” and/or “association” web sites is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Baker and Wical would be performed the same regardless of the type of web sites.

As per claim 11, obtaining said information over the Internet obviously indicates using a publicly accessible search engine (Baker; C. 3, L. 25-26).

As per claims 13-14, see claim 1.

Claims 2-4, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker and Wical in view of Johnson et al. (US 6,553,385).

As per claims 2-4, Baker and Wical teach all the limitations of claims 2-4, including storing web site addresses of accessed files (C. 6, Table II), except evaluating a confidence level of the results of the search.

Johnson et al. (herein after Johnson) teaches a method and system for information extraction from documents, wherein a confidence measurement is applied to the search results (column 10, lines 20-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include documents found comprises evaluating a confidence level of the results of the search, because it would allow to determine which searching technique is the most accurate, thereby enhance the performance of the system.

As per claims 30 and 32, Baker and Wical teach: a searching means for obtaining structured database information over the Internet; said information is related to a company management record, management title record, management background, contact names, including addresses, telephone and fax numbers, web site and email addresses (Baker; Fig. 2; C. 3, L. 25-28; C. 6, Table II; C. 7, L. 25-41); a parsing means and tense evaluation means for determining a past tense relationship of the extracted title and name records (Wical; C. 78, L. 14-15).

However, Baker and Wical do not teach an integrity evaluation means for determining whether said obtained information is valid.

Johnson teaches a method and system for information extraction from documents, including a means for confidence (*integrity*) measurement of the search results (column 10, lines 20-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include a means for evaluation of the integrity level of the obtained information, as disclosed in Wical, because it would allow to determine which searching technique is the most accurate, thereby enhance the performance of the system.

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Claim 12 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker and Wical in view of Lawrence et al. (US 6,289,342).

As per claim 12, Baker and Wical teach all the limitations of claim 12, including obtaining said information over the Internet (Baker; C. 3, L. 25-26), except using a custom designed spider.

Lawrence et al. (hereinafter Lawrence) teaches autonomous citation indexing and literature browsing using citation context, wherein a "crawler" (*spider*) module is employed (C. 29, L. 29-35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include that said information was obtained using a spider, as disclosed in Lawrence, because without indicating the advantage of using a spider over the prior art, using said spider is appears to be a matter of business choice.

Information as to "*custom designed*" spider is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Also, Lawrence teaches:

As per claims 18-19, using identifiers to locate said data (C. 8, L. 65 – C. 9, L. 28).

As per claims 20-21, rating said business data (C. 11, L. 8-9).

As per claim 22, using inclusion and exclusion characteristics to extract said business data (C. 12, L 7-11).

As per claim 23, normalizing said business data (column 12, lines 7-23; column 14, lines 29-67).

As per claim 24, eliminating duplicate sets of business data (column 8, lines 8-9);

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker and Wical in view of Maddalozzo, Jr. et al. (US 6,460,060).

As per claim 15, Baker and Wical teach all the limitations of claim 15, except that said files are located using a previously generated list of said files.

Maddalozzo, Jr. et al. (hereinafter Maddalozzo) teaches a method and system for searching web browser history, wherein searching for files over the Internet is based on the previously generated list of said files (C. 2, L. 37-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include that searching for files over the Internet is based on the previously generated list of said files, as disclosed in Maddalozzo, because it would allow to save time during browsing the "favorite" sites, thereby make the browsing convenient to users.

Claims 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker and Wical in view of Yong (US 6,560,606).

As per claims 25-26 and 28, Baker and Wical teach all the limitations of claims 25-26 and 28, except extracting date or time stamps of said files containing said information.

Yong teaches a method and system for processing of metered data, including extracting time stamps of the located files (C. 7, L. 48-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker and Wical to include extracting time stamps of the located files, as disclosed in Yong, because it would allow to differentiate fees for using said system in accordance with peak hours, thereby providing billing flexibility to the users.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, Wical and Maddalozzo in view of Yong (US 6,560,606).

As per claim 27, Baker, Wical and Maddalozzo teach all the limitations of claim 27, including searching for files based on the previously generated list of said files (Maddalozzo; C. 2, L. 37-45), except extracting date or time stamps of said files containing said information.

Yong teaches a method and system for processing of metered data, including extracting time stamps of the located files (C. 7, L. 48-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baker, Wical and Maddalozzo to include extracting time stamps of the located files, as disclosed in Yong, because it would allow to differentiate fees for using said system in accordance with peak hours, thereby providing billing flexibility to the users.

Response to Arguments

Applicant's arguments with respect to claims 1-15 and 18-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

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or faxed to:

(703) 305-7687 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

SPB


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